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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,453	02/12/2002	Atsushi Takahashi	P07439US00/BAS	6466

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EXAMINER

MARX, IRENE

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 09/11/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,453

Applicant(s)

TAKAHASHI ET AL.

Examiner

Irene Marx

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

The application should be reviewed for errors. Error occurs, for example, in claim 4 in the spelling of "Enthrobacteriaceae", and in claim 9 in the spelling of "epe"..

In keeping with scientific custom, the names of genera and species of microorganisms should be underlined or italicized throughout the specification and claims.

The amendment filed 8/4/03 is acknowledged. Claims 1-22 are presented for examination.

The traversal is persuasive regarding the rejoinder of groups I and II because the steps of the invention of group I are required for group II. The strain of group III will also be rejoined.

Claims 1-19 and 22 are being considered on the merits. Claims 20 and 21 are withdrawn from consideration as directed to a non-elected invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 19 is rejected under 35 U.S.C. 101 because this claim reads on the organism per se which is found in nature and thus, is unpatentable to applicant. Consequently, the claim does not embody patentable subject matter as defined in 35 USC 101. See, e.g., *American Wood v. Fiber Disintegrating Co.*, 90 U.S. 566 (1974); *American Fruit Growers v. Brogdex Co.*, 283 U.S. 1 (1931); *Funk Brothers Seed. Co. v. Kalo Innoculant Co.*, 33 U.S. 127 (1948); *Diamond v. Chakrabarty*, 206 U.S.P.Q. 193 (1980).

It is suggested that applicant use the language "a biologically pure culture" in connection with the strain to identify a product that is not found in nature.

Rejections under 35 U.S.C § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 5, 13 and 19 is are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The invention appears to employ novel strains *Xanthomonas* FERM BP-7168, *Pseudomonas* FERM BP-7170 and *Erwinia* FERM BP-7169. It is not clear if the written description is sufficiently repeatable to avoid the need for a deposit. Further it is unclear if the starting materials were readily available to the public at the time of invention.

It appears that a deposit was made in this application as filed as noted on page 42 of the specification. However, it is not clear if the deposit meets all of the criteria set forth in 37 CFR 1.801-1.809. Applicant or applicant's representative may provide assurance of compliance with the requirements of 35 U.S.C § 112, first paragraph, in the following manner.

SUGGESTION FOR DEPOSIT OF BIOLOGICAL MATERIAL

A declaration by applicant, assignee, or applicant's agent identifying a deposit of biological material and averring the following may be sufficient to overcome an objection and rejection based on a lack of availability of biological material.

1. Identifies declarant.
2. States that a deposit of the material has been made in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted. The depository is to be identified by name and address.
3. States that the deposited material has been accorded a specific (recited) accession number.
4. States that all restriction on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent.
5. States that the material has been deposited under conditions that access to the material will be available during the pendency of the patent application to one determined by the Commissioner to be entitled thereto under 37 CFR 1.14 and 35 U.S.C § 122.
6. States that the deposited material will be maintained with all the care necessary to keep it viable and uncontaminated for a period of at least five years after the most recent request for the furnishing of a sample of the deposited microorganism, and in any case, for a period of at least thirty (30) years after the date of deposit for the enforceable life of the patent, whichever period is longer.

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7. That he/she declares further that all statements made therein of his/her own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the instant patent application or any patent issuing thereon.

Alternatively, it may be averred that deposited material has been accepted for deposit under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the purpose of Patent Procedure (e.g. see 961 OG 21, 1977) and that all restrictions on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent.

Additionally, the deposit must be referred to in the body of the specification and be identified by deposit (accession) number, date of deposit, name and address of the depository and the complete taxonomic description.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is confusing and incomplete in that it lacks a positive recitation of the contacting of a microorganism with myo-inositol. The limitations of claim 6 should be added to claim 1.

Claim 14 is confusing in the recitation of "this culture broth" at line 6, page 69. the antecedent basis thereof is unclear. The multiple recitations of "namely" render the claim confusing as to what is intended, because the terminology appears redundant or contradictory.

Claims 14 and 15 appear to be substantial duplicates.

Claims 1-4, 6-12, 14-18 and 22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the production of L-eri-2-inosose with the specific strains *Xanthomonas* FERM BP-7168, *Pseudomonas* FERM BP-7170 and *Erwinia* FERM BP-7169 does not reasonably provide enablement for the production of this composition with any microorganism, with any bacterium, with any gram-negative bacterium or with any one

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of the bacteria recited broadly in claim 4. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

From the record of the present written disclosure, strains *Xanthomonas* FERM BP-7168, *Pseudomonas* FERM BP-7170 and *Erwinia* FERM BP-7169 are the only strains capable of the production of the required product. Therefore these are the only strains enabled by the present specification therefor, provided, of course, that all deposit requirements are met.

It would require undue experimentation for one skilled in the art to determine which other microorganisms or bacteria or bacteria within the recited genera would be suitable for the claimed invention, in view of the enormous diversity of microorganisms and bacteria encompassed by the claims and the difficulty in isolating strains from nature, especially in the absence of a specific screening assay. Ex parte Jackson, 217 USPQ 804 (Bd. App. 1982).

Undue experimentation would be required to practice the invention as broadly claimed due to the quantity of experimentation necessary to isolate and identify microorganisms or bacteria capable of the claimed bioconversion. It is noted that the term "microorganism" encompasses not only bacteria, but also fungi, yeasts, viruses, protozoa and plant and animal cells. In addition, the variety and diversity of bacteria is daunting. The amount of guidance and number of working examples in the specification is limited to the results presented for three specific strains, one of which is presently under examination. Moreover, the invention is unpredictable and only by trial and error can suitable microorganisms or bacteria be identified. For example, Posternak (1962) demonstrates that even though myo-inositol is biotransformed to inosose, the product obtained is not L-epi-2-inosose, but rather an optically inactive compound or scyllo-ms-inosose (See, e.g., page 294). In re Wands, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Thus, the scope of the claims is not commensurate with the teachings of enablement of the specification.

The references cited show the microbial biotransformation of inositols to inososes.. However, these reference fail to disclose or fairly suggest the biotransformation of myo-inositol to L-epi-2-inosose and the further reduction of the compound produced to yield epi-inositol and myo-inositol as claimed.


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Claims 5, 13 and 19 would be allowable upon resolution of all issues under 35 U.S.C § 101 and 112.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is 703-308-2922. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 703-308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0926.


Irene Marx
Primary Examiner
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